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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,458	02/12/2007	Paul L. Scherzer	10058/00005	4133
23380 7590 04/15/2009 TUCKER ELLIS & WEST LLP 1150 HUNTINGTON BUILDING 925 EUCLID AVENUE CLEVELAND, OH 44115-1414				
EXAMINER CUEVAS, PEDRO J				
ART UNIT 2834		PAPER NUMBER		
NOTIFICATION DATE 04/15/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/576,458

**Applicant(s)**

SCHERZER, PAUL L.

**Examiner**

PEDRO J. CUEVAS

**Art Unit**

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-6 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 8-11 and 13-15 is/are rejected.
- 7) ☒ Claim(s) 12 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on March 17, 2009 have been fully considered but they are not persuasive.
2. In response to applicant's argument that "*Newton does not teach or suggest receiving naturally occurring pressurized gas from a reservoir of naturally occurring gas and using the naturally occurring pressurized gas to generate electrical power as is taught by independent claims 1 and 5.*", it must be noted that it would have been obvious to one having ordinary skill in the art at the time the invention was made to use any naturally occurring gas instead of liquefied natural gas, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.
3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1, 4, 5, 8, 10, 11, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,479,350 to Newton et al.

Newton et al. disclose the construction of a system for the recovery of power from vaporization of liquefied natural gas, comprising:

means (45) adapted for receiving gas that is pressurized at a first pressure level from a gas reservoir system (Figure 1);

means (26) adapted for directing the pressurized gas to a turbine (27) so as to induce motion thereof;

a generator (30), mechanically coupled to the turbine, the generator including means for generating an electrical current induced from motion of the turbine; and

means (31) adapted for directing the gas from the turbine, after passage therethrough, to a predetermined location.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use any naturally occurring gas instead of liquefied natural gas, since it has been held to be within the general skill of a worker in the art to select a known material on

the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

7. It must be noted that it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

8. With regards to claim 4, Newton et al. disclose the gas reservoir and the predetermined location are in direct mutual communication (Figure 1).

9. With regards to claim 5, Newton et al. disclose (see column 2, line 44 to column 6, line 7) a method for exploiting power from a pressurized gas reservoir comprising the steps of:

receiving gas that is pressurized at a first pressure level from a reservoir of gas;  
directing the pressurized gas to a turbine so as to induce motion thereof;  
generating, at a generator mechanically coupled to the turbine, an electrical current induced from motion of the turbine; and  
directing the gas from the turbine, after passage therethrough, to a predetermined location at a secondary pressure level.

10. With regards to claim 8, Newton et al. disclose the reservoir of gas and the predetermined location are in direct mutual communication.

11. With regards to claims 10 and 14, Newton disclose the predetermined location being a second reservoir.

12. With regards to claims 11 and 15, it would have been obvious to one with ordinary skill in the art to make a secondary recovery site the predetermined location for the purpose of allowing system scalability and working fluid re-use.

13. With regards to claim 13, a recitation of the intended use of the claimed invention (“... *for using at least a portion of the electrical current to drive an associated compressor ...*”) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

It should be emphasized that “apparatus claims must be structurally distinguishable from the prior art.” MPEP 2114. In *In re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959), it was held that apparatus claims must be distinguished from prior art in terms of structure rather than function. In *Hewlett-Packard Co. v Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), the court held that: “Apparatus claims cover what a device is, not what it does” (emphases in original). To emphasize the point further, the court added: “An invention need not operate differently than the prior art to be patentable, but need only be different” (emphases in original).

14. Claims 2, 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. U.S. Patent No. 4,479,350 to Newton et al. in view of U.S. Patent No. 4,329,842 to Hoskinson, deceased.

Newton et al. disclose the construction of a system for the recovery of power from vaporization of liquefied natural gas as disclosed above.

However, it fails to disclose means adapted for directing gas at the secondary pressure level to an associated combustion generator so as to generate additional electrical current from combustion thereof.

Hoskinson disclose the construction of a power conversion system utilizing reversible energy of liquefied natural gas, comprising means (32) adapted for directing gas at the secondary pressure level to an associated combustion generator (34) so as to generate additional electrical current from combustion thereof.

It would have been obvious to one skilled in the art at the time the invention was made to use the means adapted for directing gas at the secondary pressure level to an associated combustion generator disclosed by Hoskinson on the system disclosed by Newton et al. for the purpose of using the gas at an increased pressure as the working fluid of a combustion generator.

It must be noted that it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

15. With regards to claim 6, Hoskinson disclose the steps of directing gas at the secondary pressure level to an associated combustion generator so as to generate additional electrical current from combustion thereof.

16. With regards to claim 9, Hoskinson disclose means (power feedback loop) adapted for using at least a portion of the electrical current to drive an associated compressor, and Newton disclose a compressor (43) which includes means for increasing the secondary pressure level.

#### ***Allowable Subject Matter***

17. Claims 12 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. The following is a statement of reasons for the indication of allowable subject matter.

The prior art of record, taken alone or in combination, does not teaches the construction of a system for exploiting power from a pressurized gas reservoir as described on and including all the disclosed limitations of dependent claims 12 and 16, comprising:

means adapted for separating at least one of nitrogen and carbon dioxide from the naturally occurring pressurized gas;

means adapted for directing the separated at least one of nitrogen and carbon dioxide to a first transmission line; and

means adapted for directing the naturally occurring pressurized gas to a second transmission line.

### ***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEDRO J. CUEVAS whose telephone number is (571)272-2021. The examiner can normally be reached on M-F from 9:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Quyen Leung can be reached on (571) 272-8188. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro J. Cuevas/  
Examiner, Art Unit 2834  
April 13, 2009

/Nicholas Ponomarenko/  
Primary Examiner, Art Unit 2834  
April 10, 2009